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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re: Application of Barry Andersen)
For: Mud Flap) Examiner: James Allen Shriver, II
Serial No.: 10/186,009)
Filed: July 11, 2003) Art Unit: 3618

**WRITTEN STATEMENT REGARDING
TELEPHONE INTERVIEW
PURSUANT TO 37 C.F.R. § 1.133(b)**

On Wednesday, September 15, 2004, a telephone interview between Examiner James Allen Shriver II and counsel for the Applicant, Paul S. Weidlich, was conducted in connection with the above-captioned matter. During the course of the interview, counsel for the Applicant and Examiner Shriver agreed upon amendments to claim 1, and by dependency therefrom claims 2-18, and claim 19, and by dependency therefrom claim 20. Moreover, according to Examiner Shriver, the agreed upon amendments appear to define over the applied prior art references and place the application in condition for allowance, subject to the pending objection to the drawings and the completion of an updated search for prior art references.

More particularly, counsel for the Applicant and Examiner Shriver agreed to amend claim 1 of the pending application as follows:

1. (currently amended) A mud flap that is adapted to be attached to a vehicle behind or outside a wheel thereof; said mud flap comprising:
 - (a) an integrally-formed, mesh panel, said panel comprising:
 - (i) a front face;
 - (ii) a top edge;
 - (iii) a plurality of strands;

- (iv) a plurality of openings defined by said plurality of strands, each of said plurality of openings having a minimum dimension of no more than 1/8 (0.125) inch;
wherein the sum of the areas of the plurality of openings represents at least 75% of the surface area of the front face of the panel; wherein the openings in the integrally-formed, mesh panel are adapted to permit air to flow therethrough; and wherein the openings in the integrally-formed, mesh panel are sized such that substantially all water and roadway debris encountered by the panel is deflected by the panel;
- (b) a means for attaching the panel to the vehicle.

Similarly, Examiner Shriver and counsel for Applicant agreed to amend original claim 19 as follows:

19. (currently amended) A method for deflecting water and roadway debris, said method comprising the following steps:
- (A) providing a mud flap, said mud flap comprising:
- (1) an integrally-formed, mesh panel, said panel comprising:
- (i) a front face;
- (ii) a top edge;
- (iii) a plurality of strands;
- (iv) a plurality of openings defined by said plurality of strands, each of said plurality of openings having a minimum dimension of no more than 1/8 (0.125) inch;
wherein the sum of the areas of the plurality of openings represents at least 75% of the surface area of the front face of the panel; wherein the openings in the integrally-formed, mesh panel are adapted to permit air to flow therethrough; and wherein the openings in the integrally-formed, mesh panel are sized such that substantially all water and roadway debris encountered by the panel is deflected by the panel;
- (B) attaching the mud flap behind a wheel of the vehicle.

As recited above, the original claim 1 and the original claim 19 of the pending application have been amended by inserting into original claims 1 and 19 the dimensional limitation recited in original claim 11. As a result of these amendments, Examiner Shriver indicated that amended claims 1-20 appear to define over the applied prior art and place the application in condition for

allowance, subject to the pending objection to the drawings and the completion of an updated prior art search.

Prior to reaching the agreed upon amendments described above, counsel for the Applicant argued that the dimensional and range limitations of the claimed invention are not obvious in view of the prior art applied. More particularly, the dimensional and range limitations of the claimed invention are not obvious in view of the applied prior art because (1) they are described as an important feature in the Specification, (2) they cause the claimed invention to perform or operate differently from the prior art, and/or (3) they cause the claimed invention to achieve different results from the prior art. As counsel for Applicant explained, these are three ways to overcome an obviousness rejection of dimensional and range limitations under the current law of the Federal Circuit. *See Gardner v. TEC Sys., Inc.*, 725 F.2d 1338 (Fed. Cir. 1984)(cited favorably 35 times by the Federal Circuit); *In re Woodruff*, 16 USPQ 1934, 919 F.2d 1575 (Fed. Cir. 1990)(cited favorably 36 times by the Federal Circuit); and *In re Gentile*, Civ. App. No. 93-1086 (Fed. Cir. 1993)(unpublished).

By contrast, counsel for Applicant argued that the decision of *In re Rose*, 105 USPQ 237, 220 F.2d 459 (CCPA 1955), which was relied upon in the Office Action, is not the standard that should be applied to this case. The *In re Rose* decision is cited in the Office Action for the proposition that a change in size is generally recognized as being within the level of ordinary skill in the art. However, as argued by counsel for Applicant, the *In re Rose* decision applies the old "invention" standard, not the current "obviousness" standard of patentability. *Id.* at p. 463. Further, the *In re Rose* decision has never been cited as precedential authority by the U.S. Court

of Appeals for the Federal Circuit. Accordingly, as counsel for Applicant argued, the precedential authority of the *In re Rose* decision must be weighed in view of the more recent decisions of the Federal Circuit cited above.

Counsel for Applicant then argued that the original Specification of the pending application expressly describes the importance of the dimensional and range limitations of the claimed invention. More particularly, the importance of the dimensional limitation of original claim 11 (*i.e.*, the minimum dimension of an opening is no more than 0.125 inches) and the range limitation of original claim 1 (*i.e.*, the openings represent at least 75% of the total surface area of the front face of the panel) is described throughout the Specification of the application. *See, e.g.*, Specification at page 5, lines 10-16; page 6, lines 21-22 to page 7, lines 1-2, 7-11, 15-16 and 23 to page 8, lines 1-4; page 10, lines 9-10; page 11, lines 21-23 to page 12, lines 1-23 to page 13, lines 1-2; page 14, lines 10-11 and 16-20; and page 19, lines 9-23 to page 20, lines 1-20.

Thus, counsel for Applicant argued that the importance of the dimensional and range limitations of the claimed invention, as defined by amended claims 1-20, is clearly described in the original Specification of the application.

Counsel for Applicant then argued that the dimensional and range limitations of the claimed invention cause the claimed invention to perform and operate differently from the applied prior art. For example, the claimed invention permits air to flow nearly unimpeded through it as a result of the openings representing at least 75% of the total surface area of the front face of the panel. By contrast, the mud flap described by U.S. Patent No. 5,273,318 of Nakayama et al.

("Nakayama") describes a mud flap through which no air may pass, impeded or otherwise.¹ U.S. Patent No. 5,366,247 of Fischer ("Fischer") describes a mud flap having angled louvers which deflect substantially all of the air that flows through the openings in the mud flap. As a result, air does not flow through the mud flap of Fischer nearly unimpeded. Instead, the downwardly angled louvers impede substantially all of the air that flows through the openings of the mud flap of Fischer. The third reference cited in the Office Action, U.S. Patent No. 5,145,617 of Hermanson et al. ("Hermanson"), does not describe how the claimed sheet material performs or operates as a mud flap.

Thus, counsel for the Applicant argued that the dimensional and range limitations of the claimed invention, as defined by amended claims 1-20, cause the claimed invention to perform and operate differently from the applied prior art.

Further, counsel for Applicant argued that the dimensional and range limitations of the claimed invention causes the claimed invention to achieve different results from the applied prior art. For example, as a result of the range limitation (i.e., the area of the openings representing at least 75% of the total surface area of the front face of the panel), the displacement of the mud flap of the claimed invention caused by air resistance is minimized. By contrast, the mud flap of

¹ Counsel for Applicant also argued that the drawings of Nakayama do not teach or suggest a mud flap having a plurality of openings that represent more than fifty percent (50%) of the total surface area of the front face of the panel. As counsel for Applicant explained, Figure 7 of Nakayama illustrates a panel in which the area of the openings represents less than fifty percent (50%) of the total area of the panel. In fact, counsel for Applicant noted that Figure 13 of Nakayama illustrates the mud flap of that patent having the highest percentage of open area to total surface area, but the percentage of open area is still less than fifty-one percent (51%) of the total surface area of the panel. Finally, counsel for Applicant again recited the express language of the specification of Nakayama which states that the "openings 7 of the front member 1 are required to be approx. 50 percent open relative to the total surface area thereof." Col. 4, lines 10-12 (emphasis added).

Nakayama must be undesirably heavy in order to overcome significant displacement caused by air resistance during transport because no air is permitted to flow through the rear panel of the mud flap. Similarly, the angled louvers of the mud flap of Fischer produce a significant amount of air resistance during transport and a corresponding undesirable displacement of the mud flap. As with Nakayama, the mud flap of Fischer must be undesirably heavy in order to overcome the displacement caused by air resistance during transport. The undesirable weight of these mud flaps reduces fuel economy and payload capacity. Further, if the mud flaps of Nakayama and Fischer are not made undesirably heavy and they are permitted to be displaced by air resistance during transport, then their utility as a means for deflecting water and other roadway debris is undesirably reduced.

In addition, as a result of the dimensional limitation of the claimed invention (i.e., the minimum dimension of each opening being no more than 0.125 inches), the mud flap of the claimed invention impedes and "catches" or prevents substantial amounts of water (including small drops of water) and other roadway debris from passing through the mud flap. By contrast, the mud flap of Fischer permits substantially all the water and small roadway debris encountered by the mud flap to pass through the mud flap, even though much of the water and debris may be deflected downwardly by the angled louvers. The results achieved by the sheet material of Hermanson as a mud flap are not described.

Thus, counsel for Applicant argued that the dimensional and range limitations of the claimed invention, as defined by amended claims 1-20, cause the claimed invention to achieve different results from the applied prior art.

Based upon the foregoing Federal Circuit decisions and the distinctions between the claimed invention and the applied prior art, counsel for Applicant concluded that the dimensional and range limitations recited by claims 1-20, as amended, are not obvious under 35 U.S.C. § 103(a). Again, Examiner Shriver agreed to the proposed amendments of claims 1 and 19, and indicated that the amendments appear to define over the applied prior art and place the application in condition for allowance, subject to the objection to the drawings and the completion of an updated search for prior art references. Examiner Shriver further recommended that counsel for Applicant present any remarks in support of Applicant's position. Counsel for Applicant agreed to prepare and file an Amendment/Response to Office Action including the amendments recommended by Examiner Shriver and the Applicant's remarks.

Respectfully submitted,



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